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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ANDREW TROSIEN *et al.*

Application No.: 09/557,382

Filed: April 25, 2000

For: TREATMENT ANALYSIS
SYSTEMS AND METHODS

Confirmation No. 8250

Examiner: FRENEL, VANEL

Technology Center/Art Unit: 3627

REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants offers this Reply Brief in furtherance of the Examiner's Answer mailed
December 11, 2007.

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1. STATUS OF CLAIMS

Claims 1-25 are currently pending and are the subject of this appeal. No other claims are pending. Claims 1-25 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,283,761 to Joao (hereinafter "Joao") in view of U.S. Patent No. 5,683,243 to Andreiko *et al.* (hereinafter "Andreiko").

2. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-25 are properly rejected under 35 U.S.C. §103(a) over Joao in view of Andreiko.

3. ARGUMENT

In Section 9 of the Examiner's Answer mailed 12/11/2007 ("Examiner's Answer"), spanning pages 3-9, the Examiner has repeated the rejections that were previously made of record (see, e.g., Office Action, mailed 7/14/2005; and Final Office Actions mailed 3/18/2003 and 5/17/2004). Since the rejections and arguments set forth in Section 9, pages 3-9 of the Examiner's Answer merely repeat, nearly verbatim, the rejections as previously made of record, and in the interest of administrative economy and efficiency, these repeated arguments will not be further addressed by Appellants in the present Reply, but remain traversed for reasons previously made of record and set forth in Appellants' Appeal Brief.

However, Appellants submit the following remarks in reply to the additional comments made in Section 10 of the Examiner's Answer. Section 10 spans pages 9-15 of the Answer, with pages 9-10 identifying selected remarks found in the Appellants' Appeal Brief (labeled arguments (i)-(iv)), and pages 10-15 including the Examiner's comments in response to the identified Appellants' remarks. As will be set forth in greater detail below, Appellants respectfully submit that Examiner's comments/arguments fail to rebut Appellants' remarks previously made of record.

A. Examiner's Response to Appellants' "First Argument"

At Section 10, pages 10-12 (section labeled "(I)") of Examiner's Answer, it is stated that "... Examiner respectfully submitted that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has *presented evidence* of corresponding claim elements in the prior art and has expressly articulated the combinations and motivations for combinations that fairly suggest Appellant's claimed invention" (*emphasis added*). However, Appellants have already addressed Examiner's "presented evidence" and specifically presented reasons why the stated case for obviousness is believed to be deficient.

In particular, as noted in Appellants' Appeal Brief, and as acknowledged in Examiner's Answer, the cited primary reference of Joao fails to teach or suggest noted elements of the presently claimed invention (See Examiner's Answer, Section 9, part A on page 3, and Section 10 on page 11, "Joao does not explicitly disclose an engine adapted to receive the dental data from the input form and validating the dental patient data in a predetermined sequence;" part K on pages 6-7, "As per claim 11, ... Joao does not explicitly disclose validating data entry to a patient treatment plan to an input form in a predetermined sequence and visualizing patient data in response to a user request;" and part P on page 8, "As per claim 16, ... Joao does not explicitly disclose validating the dental data in a predetermined sequence.") To supply the teachings that Examiner has indicated are missing from Joao, Examiner relies upon Andreiko (See Examiner's Answer, Section 9, parts A, K, and P, on pages 3, 6-7, and 8 respectively; and Section 10 on page 11). However, as has been specifically addressed by Appellants' remarks previously made of record, Andreiko fails to teach or suggest the above noted elements missing from Joao, thereby precluding *prima facie* obviousness.

These remarks have not been rebutted by the Examiner in the Answer. Instead of rebutting or specifically addressing Appellants' remarks, the Examiner has essentially repeated, nearly verbatim, the arguments previously made of record. Applicants respectfully submit these arguments are deficient for reasons previously made of record and that merely repeating them adds little, if anything, to the record to support the rejections.

B. Examiner's Response to Appellants' "Second Argument"

At Section 10, pages 12-13 (section labeled "(II)") of Examiner's Answer, it is stated that the Examiner relied on the teachings of Andreiko to provide the elements of the claim missing from Joao. However, Andreiko is deficient for reasons previously made of record.

This section of Examiner's Answer further references a newly cited portion of Andreiko. However, even this newly cited portion fails to show that Andreiko teaches the elements that are missing from Joao. The newly cited portion of Andreiko is repeated below:

The orthodontist 14 then communicates the information 16, for example, by transmitting the model 20, the prescription for treatment 27, a record of information 17 identifying the doctor 14 and the patient 12, together with information 19 containing statistical and historic data of the patient 12, to an appliance design facility 13, at some remote location. At the appliance design facility 13, the information 16 is digitized and input into the computer 30 for analysis. Alternatively, the orthodontist 14 may convert the information 16 to digital computer readable form and transmit the digitized information to the appliance design facility 13. In this alternative, the system 10 would be configured with the input computer 30 located at the orthodontist's office 11, and the orthodontist 14 or assisting personnel would perform portions of an data input procedure (94) *described below*.

(See Andreiko, Col. 21, lines 1-15, "*described below*" not quoted by Examiner). Yet, this portion, like previously cited portions of Andreiko, fails to show "an engine adapted to receive the dental patient data from the input form and validating the dental patient data in a predetermined sequence" or "validating data entry relating to a patient treatment plan to an input form in a predetermined sequence and visualizing patient data in response to a user request." While this portion shows data being input into a computer for subsequent analysis, there is no mention that the data is subjected to validation. Therefore, this newly cited portion of Andreiko, like all of the previously cited portions of Andreiko, fails to reasonably teach or suggest the above noted elements missing from Joao.

C. Examiner's Response to Appellants' "Third Argument"

At Section 10, pages 10-12 (section labeled "(I)") of Examiner's Answer, it is stated that "... it is respectfully submitted that Examiner relied upon the clear and unmistakable

teaching of Joao for such a feature." To begin with, Applicants are unclear as to exactly what claim element (feature) Examiner is now citing to Joao as allegedly teaching. As indicated above, and noted in Examiner's Answer, Examiner has already indicated that Joao fails to teach the element of "an engine adapted to receive the dental patient data from the input form and validating the dental patient data in a predetermined sequence" (see Section 9, Part A on page 3; and Section 10 on page 11) or "validating data entry to a patient treatment plan to an input form in a predetermined sequence and visualizing patient data in response to a user request" (see Section 9, Part K, on pages 6-7). As noted above, Appellants have previously set forth reasons why Andreiko fails to cure the deficiencies of Joao. As such, contrary to Examiner's comments in the Answer and elsewhere, the proposed combination of Joao and Andreiko fails to provide all the elements of the claimed invention.

Further, although this section of Examiner's Answer references newly cited portions of Joao, the newly cited portions fail to show that Joao teaches the elements that Examiner's Answer indicates are missing from Joao. These provisions of Joao are cited by the Examiner as indicating that the teachings of Joao may be practiced on the World Wide Web, or various other networks or systems. (See Examiner's Answer, section "(III)" on page 13, citing Joao, Col. 15, lines 18-47; Col. 15, lines 59-67 to Col. 16, line 18). However, the newly cited provisions of Joao would still fail to teach or suggest the claim elements that Appellants have already pointed out as missing from the cited references. In particular, these portions fail to teach the claim elements regarding the validation of data in a predetermined sequence. Accordingly, Applicants' stated reason for the failure of the cited references to teach the claimed invention stand.

D. Examiner's Response to Appellants' "Fourth Argument"

The Examiner has failed to provide some articulated reasoning with some rational underpinning necessary to support the legal conclusion of obviousness. A case of obviousness requires ascertaining the scope and contents of the cited references, and ascertaining the differences between the cited references and the claims at issue, as well as the level of ordinary skill in the art. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966); *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727. While specifically demonstrating a teaching, suggestion, or motivation to combine references is not strictly required, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Intern. Co. v. Teleflex Inc.*, at 1741. And "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *Id.* at 1742. For the reasons stated above and previously made of record, Applicants respectfully submit that Examiner has failed to establish a *prima facie* case of obviousness due the failure of the cited references to teach or suggest all of the elements of the presently claimed invention.

Additionally, Examiner's response at Section 10, pages 10-12 (section labeled "(IV)") of Examiner's Answer, fails to address the issue actually raised in Appellants' Appeal Brief. At page 10 of Appellants' Appeal Brief, Appellants noted that in the Final Office Action dated May 17, 2004, on page 3, Examiner admits that "Andreiko does not *explicitly* teach a validation engine," but instead cited a portion of Andreiko for *suggesting* a data validation engine (*emphasis added*). Appellants' presented in the Appeal Brief the cited portion of Andreiko and pointed out that there is no teaching, suggestion or motivation whatsoever in this cited section about a data validation engine, or rationale to further modify Andreiko to include a data validation engine. Since the Examiner had failed to offer or establish evidence of rationale to support the allegation that Andreiko suggests a data validation engine, and further considering that this element admittedly is not explicitly taught in Andreiko, Appellants noted that the Examiner's reading of Andreiko appeared to be impermissibly tainted by hindsight based

analysis. It was in this context that Appellants' Appeal Brief indicated that "hindsight reconstruction is impermissible" so as to emphasize that it is impermissible to find the suggestion of a data validation engine in Andreiko by way of hindsight reconstruction using Applicants' own disclosure.

Instead of addressing the above issue raised by Appellants in the Appeal Brief, Section 10, page 14, of Examiner's Answer states "... the Examiner respectfully notes that each and every motivation *to combine the applied references* are accompanied by select portions of the respective reference(s) which specifically support that particular motivation ... As such, it is NOT seen that Examiner's *combination of references* is unsupported by the *applied prior art of record*" (*emphasis added*). As such, while Appellants' argument was directed toward the failure of the Examiner to support his assertion that Andreiko *suggests* a data validation engine, whereas the Examiner's Answer appears to be directed to the separate issue of motivation to modify Joao with Andreiko. As such, the arguments in the Answer would not appear to rebut Appellants comments set forth in the Appeal Brief regarding the deficiencies of Andreiko and impermissible hindsight reconstruction.

Regardless, even if, for arguments sake only, Joao and Andreiko are combined, Applicants respectfully maintain that the proposed combination would still fail to teach or suggest the claimed invention for at least the reasons stated above and previously made of record. As such, not only do the rejections lack "the articulated reasoning with some rational underpinning" necessary "to support the legal conclusion of obviousness" (*KSR Intern. Co. v. Teleflex Inc.*, at 1741), but would fail to teach or suggest each elements of the present claims even if combined as suggested.

4. CONCLUSION

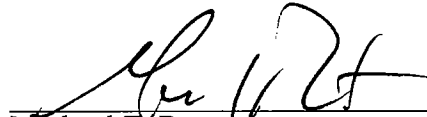
For the reasons set forth above, it is respectfully submitted that the rejection should be reversed.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this Reply Brief, the Examiner is invited to telephone the undersigned at 206-467-9600.

Respectfully submitted,

Date: _____

2/1/2008



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